

REMARKS

Enclosed herewith is a Request for an Extension of Time and the appropriate fee.

Applicant agrees to comply with 37 CFR 1.178.

The Office Action rejected the declaration and the claims on basically one issue, an assertion that the present claims were subject to an improper recapture of subject matter surrendered in the prosecution of the parent patent (Recapture Rule).

The Office action acknowledged that the amendment of the claims and the arguments during prosecution were directed at “piece of page information” and “plurality of screen images”, but conjectured that “it appears that the amendment constitutes an attempt to recapture.”

Applicant respectfully traverses this position and believes that a careful review of the cited cases more than adequately justifies the reissue of this patent.

The Ball Corporation v. United States, 729 Fed 2nd 1429 (Fed. Cir. 1984) involved a dual slot antenna assembly for a missile and more particularly to an electrical signal feedline for exciting the antenna. In the prosecution of the original claims the Examiner specifically rejected the claims calling for a single feedline element. The Examiner in the First Office Action stated specifically that he would allow claims if they were “limited to a plurality of feedlines”. A response and amended claims were submitted and a second rejection was made final with the Examiner again suggesting the allowable of a plurality of feedlines claims if presented in independent form, see page 1432. Applicant responded by accepting the Examiner’s suggestion and permitting the claims to issue.

Subsequently, the Applicant filed a reissue application contending that an error existed and that he should be permitted to submit a claim limited to a single conductive lead.

The subject matter had been presented in the canceled Claim 8.

The Federal Court of Appeals noted a clear correspondence with the single feedline from the canceled claims, and the written suggestion of allowance by the Examiner based on a claim amendment to a plurality of feedlines. The Court however, rejected the Government contention that this subject matter was barred by the Recapture Rule, based on claim subject matter previously canceled from the original application. Court noted that a reissue is remedial in nature and was based on fundamental principles of equity and fairness and the Recapture Rule was not limited to a strict reading of a cancellation of a claim. The Court found that the extent to which a deliberate cancellation of a claim from an original application may prevent a patentee from obtaining other claims, differing in form or substance from that of the cancel claim “depends upon the facts of each case and particularly on the reasons for cancellation” see page 1438.

Needless to say, our fact pattern and our circumstances are different from the Ball Corporation case and the only relevance of that decision is the statement of equity and a liberal interpretation of the Recapture Rule. Some of our claims inadvertently included an adverb “successively” referring to an act of storing in a storage space in original Claim 1 and other claims. The Office Action indicated allowed subject matter in certain dependent claims while rejecting for example, Claim 1 over a combination of the *Ohba et*

al. U.S. Patent No. 5, 214,758 and the *Edmunds et al.* U.S. Patent No. 5,592,602.

A close reading of the Office Action clearly discloses that the Examiner never mentions, refers to or implies that “successively” in anyway represented an issue in contention in the case.

Rather the *Ohba et al.* reference was cited to include a disk with page information including a partial image, information reading means, a display data creation means, display means, input means and a command execution means. The Office Action further acknowledged that the *Ohba et al.* reference did not disclose page information including display state information and control information, but rather relied upon the *Edmunds et al.*, reference to disclose apparatus for segmenting a multimedia object’s duration into a plurality of time segments. The Examiner then concluded that it would be obvious to a person with ordinary skill to integrate a disk with page state information and control information with various time segments of an object’s duration on display.

The Examiner further combined the MacroModel text with the *Ohba et al.* and *Edmunds et al.*, references to teach a method for building images for animation including a display and method to modify X-Y coordinates, along with a rotation tool to allow rotation of the object. Finally, the Examiner cited the *Silverbrook* U.S. Patent No. 5,566,290 for combination with *Ohba et al.*, and *Edmunds et al.*, for the teaching of a multimedia display device for storage, production and reproduction with connection to a network interface. The Examiner indicated allowable subject matter was contained within dependent claims.

The term “successively stored” was never an issue of allowance nor a basis for a rejection.

Applicant in the Amendment of August 25, 1997, responded with amendments set forth to address 35 USC § 112 issues and with regards to Claim 1, modified the definition of the page information to indicate that it was pieces of page information and further modified the Claim to identify what each piece of the page information was made up of, namely, multimedia information that describes contents of a plurality of screen images. The original claim language, that inadvertently included the term “successively stored”, was never addressed in the amended claim nor in fact in the arguments presented relative to the cited references. Thus, the Applicant when initially describing the invention had inadvertently used the word “successively” as an unnecessary limitation relative to the act of storing the pieces of page information in a storage area.

Further undermining the contention that “successively” stored was a necessary limitation to distinguish over the prior art, it should be noted, that Claim 13 was also rejected over the same references of *Ohba et al.*, and *Edmunds et al.*, when further combined with *Silverbrook* for showing information that was provided by a data server over a network. Note, Claim 1 referred to the data being on a disk, while Claims 13 and 19 were not limited to a disk, but received information by a network. Faced with the same rejection, Applicant, again, provided amendments to Claims 13 and 19 that were only directed to further describing the piece of page information as being made up of multimedia information that describes the content of the plurality of screens images. In

Claim 13, the language called for a page information read means for reading the piece of page information without any reference to “successive stored” while Claim 19 referred to a page information storage means for having a plurality of separate small storage areas for which each can store at least a piece of page information. Claim 19 further defined a control information write means for writing the controlled information into a second storage area in the page information storage means, but made no reference to a “successive” storage capability.

Thus, the actual claims allowed and the prosecution history clearly discloses that there was no intention exhibited by the Applicant in inadvertently leaving the terminology “successively” in certain claims, while not having it in other claims that were allowed over the same references of record.

The present Office Action contended that Claims 1-26 were rejected under 35 USC §251 as being an improper recapture of claim subject matter surrendered in the parent application. The Office Action attempted to construed Applicant’s comments on the cited prior art rejection as including arguments that the prior art failed to teach pieces of page information successively stored in a storage area in a disk. The Office Action however, in fairness noted that the emphasis of the argument involved the aspect of pieces of page information and plurality of screen images. The Office Action misconstrues apparently the first full paragraph on page 34 as allegedly an argument that would support a Recapture Rule. Comparing the first sentence of this paragraph however, with Claim 1 amended, clearly discloses the intent of the Applicant to simply

substantially repeat the amended sub-paragraph “a” with an actual emphasis on the underlying pieces of page information. Thus, the first sentence is basically a quotation of sub-paragraph (a) and simply repeated the terminology “successively stored in a storage area” to define the context of Claim 1. It can be readily seen however, that other independent claims for which the same arguments over the prior art were applied were not so limited and that there was no intent in Applicant making any type of argument based on “successively stored in a storage area on a disk”. The actual argument advanced against the cited references is found in the contents of pages 34-35 as follows:

Accordingly, the idea of reading out a piece of page information which includes a plurality of screen images from a disc is not disclosed or suggested by the combination of Ohba et al. and Edmunds et al.

Meanwhile, the claims of the present invention recite that a piece of page information describing the contents of a plurality of screen images are stored on a disc, where a plurality of screen images are read at a time with the piece of page information being read. As result, the multi-media playback device of the present invention can reproduce highly responsive multi-media data, even if the transfer rate of disc data from a CD-ROM is low. The amount of display data which can be displayed per unit time is not limited by the data transfer rate between the disc and the memory.

Thus, the display image update is prevented from being suspended upon

awaiting information from the disc, so that the multi-media information playback device will rarely be in a waiting state.

As can be seen, the Examiner allowed not only Claim 1 without any reference to successively stored, but further allowed Claims 13 and 19 that don't mention successively stored. Note for example, the Reasons for Allowance submitted by the Examiner in the Notice of Allowability of November 26, 1997 at page 2. There is clearly no discussion or suggestion that the claim terminology "successively" was a factor in the allowance of either Claims 1, 13 and 19.

Applicant accordingly respectfully submits that the prosecution of the parent related case is not capable of supporting an application of a Recapture Rule as alleged in the rejection.

Applicant further submits that the present declaration is not defective under 35 U.S.C. 251 and 37 CFR Section 1.175(b)(1).

Further, as noted on page 35 paragraph 3 of the amendment in the present application, it describes "Storing a piece of page information describing the contents of a plurality of screen images on a disc and reading a plurality of screen images from the disc at one time when the piece of page information is read", and this portion is followed by the understanding that the claimed limitation is not taught nor suggested by the cited references.

The Examiner cited the above sentence in his statement of Reason for Allowance issued on November 26, 1997.

In re Clement, 131 F.3d 1464 (Fed. Cir. 1997) contained a factual situation where the Applicant specifically surrendered subject matter by amending the original claims over the prior art. Thus, this case was like the Ball Corporation case mentioned above. The Court noted at page 1469 that to determine whether the Applicant surrendered particular subject matter it must look to the prosecution history for arguments and changes to claims made in an effort to overcome a prior art rejection. The Court further noted that the Recapture Rule "does not apply in the absence of evidence that the Applicant's amendment was 'an admission that the scope of the claim was not in fact patentable.'" In our present situation the Recapture Rule does not apply since successively was erroneously included in some of the original claims of the application and there was never an amendment to add the word "successively" or to delete it. The amendments to the claims did not relate at all to the matter of successively storing information.

The present invention can accomplish the broader aspects of its invention including limiting seek time even if information is not stored in successive storage areas on a disk. Thus, this information could be stored in every other one or every third storage space or any other logical combination and the same advantages of the present invention are achieved since the purpose of the present invention is unrelated to any issue with regards to successively as argued and acknowledged in the Examiner's Reasons for Allowance.

The case of *Hester Industries, Inc. v. Stein, Inc.*, 142 F. 3d, 1472 (Fed. Cir. 1998) also disclosed a reissue claim that was attempting to be broader on two claim elements that had been repeatedly argued as the basis for allowing the original claims over the cited art. The Court noted the inventor had argued no less than 27 times in six papers submitted to Patent Office that a “solely with steam” limitation distinguishes the invention from the prior art and further argued at least 15 times that the limitation “two sources of steam” also distinguish over the prior art.

In our present prosecution history we have one amendment which is acknowledge by the Office Action to be basically arguing reading a plurality of screen images when a piece of page information is read and changing the display data by merely changing the display state of the corresponding partial image being changed according to input control information. The references of record failed to teach these features and the original claims were allowed.

Our present reissue application does not attempt to recapture the actual amended language for which these arguments were cited for support. The present reissue claims are attempting to resolve an inadvertent error in defining “successively” when it is not a requirement to practice the present invention nor did the prior art require such a limitation as can be seen by the other issued claims of record.

It is believed the case is allowable and an early notification of such is requested.

If the Examiner believes that a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed telephone number.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Honorable Commissioner of Patents, Washington, D.C. 20231, on May 28, 2002

By: Marc Fregoso

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Signature

Date: May 28, 2002

Very truly yours,

PRICE AND GESS

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